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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,655	03/14/2002	Yaacov Almog	UDX	2825

26418 7590 08/26/2004
REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER

HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,655

Applicant(s)

ALMOG ET AL.

Examiner

Bruce H Hess

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-26-04 (IDS and Amendment)
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 26, 28-57 and 60-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26, 28-57 and 60-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3-26-04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

1. Upon reconsideration, the indication of allowable subject matter has been withdrawn.
2. Claims 1, 5-24, 26, 28-33, 37-57 and 60-64 are rejected under 35 USC 112 (first paragraph) as being broader than the enabling disclosure as a result of applicants' failure to recite the presence of a polymeric binder in their film coating.
3. Claims 15 and 47 are again rejected under 35 USC 112 (second paragraph) as being indefinite for the reasons of record. The submission of non-patent literature with a publication date later than applicants' filing date fails to overcome this rejection. On the contrary, it strengthens the examiner's position that the terms in question at the time of applicants filing did not have a well-defined scope and meaning.
4. Claims 1-4, 10-14, 23, 24, 26, 28-36, 42-46, 55-57 and 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Desjarlais et al. (U.S.P.5,308,680), Kulkarni et al. (U.S.P. 5,411,787) or Henry et al. (U.S.P. 5,518,809).

Claims 16-22 and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Desjarlais et al., Kulkarni et al. or Henry et al. in view of applicants' statement of the prior art.

These patents all teach printing methods wherein toners are applied to a substrate (e.g., polyester) coated with a film coating comprising polymeric (e.g., acrylic) binder and at least 25 wt. % nano-silica. The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine the size of the silica particles) fails to render applicants' claims patentable in the absence of unexpected results. Applicant acknowledge in their specification that anchorage agents are known

Art Unit: 1774

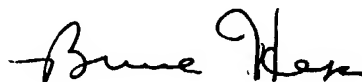
in the art. Consequently, use of these known compounds for their concomitant function in the printing material of the primary references would have been an obvious expedient to one of ordinary skill in this art in the absence of unexpected results.

Applicants' attention is directed to the fact that their specification examples demonstrate that unexpected results are obtained when ≥ 29 wt. % of nano-silica is employed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (571) 272-1525. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bruce Hess/mn
6/30/2004

BRUCE H. HESS
PRIMARY EXAMINER